

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID A. WOLFF

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Appeal No. 96-3648  
Application 07/685,563<sup>1</sup>

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HEARD: APR. 7, 1998

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Before KRASS, STAAB, Administrative Patent Judges, and MCKELVEY,  
Senior Administrative Patent Judge

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This design application is on appeal from the final  
rejection of the only claim pending.

The subject matter of the invention is the design for a golf  
ball marker which has a generally crescent shape.

A prior decision was rendered (Paper No. 15-October 31,  
1994) wherein a rejection of the claimed subject matter under

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<sup>1</sup> Application for patent filed April 12, 1991. According to  
appellant, this application is a continuation of Application No.  
07/541,336, filed June 21, 1990, now abandoned.

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35 U.S.C. ' 103 was reversed. The examiner now cites new prior art, U.S. Patent No. 3,850,434 to Ockenfels against the claim under 35 U.S.C. ' 102(b).

Reference is made to the briefs and answers for the respective positions of appellant and the examiner.

#### OPINION

We reverse.

In order to establish an anticipation, under 35 U.S.C. ' 102, of a claimed design, the examiner must demonstrate that a prior art reference describes subject matter which is identical in all material aspects as the claimed design.

Accordingly, we look to the identity of appearances or sameness between the game board design of Ockenfels and the golf ball marker design of the instant invention in order to determine the appropriateness of the examiner's rejection under 35 U.S.C. ' 102.

While both sides argue the difference or de minimus nature between the curves of the crescent designs of both Ockenfels and the instant invention, we need not reach that issue since the two designs are not identical in all material aspects, in the sense of 35 U.S.C. ' 102, for other reasons.

The instant claimed invention is a three-dimensional design for a golf ball marker having a crescent shape, in top view, as shown in Figure 1, and a relatively thin height, or thickness, in

the side view, as shown in Figure 2. The game board of Ockenfels, albeit crescent-shaped, describes no specific discernible thickness. The examiner does not dispute that Ockenfels shows only a single view of the game board but argues that "it has long been accepted in the art to describe the thickness of a game board as being conventional with no visual disclosure" [principal answer-page 4]. The examiner also employs a dictionary definition of "board" to contend that it means a sheet of relatively thin material.

We do not gainsay that a game board usually has a relatively thin "thickness" and that most "conventional" game boards may well be relatively thin. However, the fact that most game boards are relatively thin does not lead to the conclusion that all game boards are inherently so. The examiner does not, and cannot, claim that all game boards are inherently relatively thin. Accordingly, while it may be that Ockenfels' game board is relatively thin, there is no certainty that it is. That lack of certainty can only lead to a conclusion that Ockenfels' crescent-shaped game board anticipates the instant claimed design under 35 U.S.C. ' 102 if we engage in unwarranted speculation derived from a knowledge of appellant's invention. This, of course, is improper in an analysis of novelty under 35 U.S.C. ' 102.

Since the claimed design is not described in the single

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applied reference, a rejection of the claimed design under  
35 U.S.C. ' 102 over Ockenfels cannot lie.

The examiner's decision rejecting the design claim under  
35 U.S.C. ' 102 based on Ockenfels is reversed.

REVERSED

Errol A. Krass	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Lawrence J. Staab	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Fred E. McKelvey, Senior	)	
Administrative Patent Judge	)	

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